

Remarks

The only ground of rejection pending appears to be a double patenting rejection over a patent (USP 6,533,819) that issued from an application that contains the same disclosure the present application. However, before turning to the substance of applicant's response, applicant would like to clarify for the record an apparent word-processing error in the stated rejection.

Two patent numbers are actually listed in the rejection. The first of these is USP 6,533,819, which applicant believes to be the intended patent number. However, there is a second patent number listed in the last sentence of the paragraph that provides the basis of the rejection (paragraph 3 of the Office Action), and this is a different patent number (USP 5,755,770) that has no relationship to the present case. Applicant understands this second number to be a word-processing (or other) error, since the claim numbers stated in the rejection are identical for the two recited patent numbers. If the '770 patent is actually intended, applicant requests that the rejection be properly stated and that a non-final period for response be granted. If the Examiner makes no comment on this issue in further papers, applicant will understand that the listing of the '770 patent was in error and that only the '819 patent was intended.

Turning now to the substance of this response, the present application was filed as a voluntary "divisional" of the application that led to the issued '819 patent (there was no actual restriction requirement as to the claims that issued in that patent and the claims pending in the present application). The *broader* claims of this application – prior to the current amendment – referred to *tissue augmentation* in general, while the earlier patent has claims that refer to replacement of *intervertebral disk material*. It is the understanding of the undersigned that the granted patent claims were considered to cover an improvement over the more general invention of "tissue replacement" that is now being claimed. Apparently, it was hoped that the current application would issue first, so that the application that issued as the '819 patent could be pursued as an improvement. (The undersigned attorney has taken over prosecution of this case from another attorney and is not privy to the thoughts of the earlier attorney). Whatever the intent, that did not

occur, so that we are now left with the narrow claims having issued first, while the broader claims are being pursued in the present application.

There is an additional complicating factor. When the current “divisional” application was filed, two of the named three inventors of the earlier application that contained both “disk” (improvement) claims and the more general claim 1-34 now under consideration were dropped, as the broader invention was understood to be made by only one of those inventors who were named in the improvement patent, namely by Dan Urry. (All three contributed to the narrower improvement claims that recite disks.) As a result of this difference in inventive entity, there is also a difference in the entities to whom the invention of the earlier patent and the current application are assigned. Accordingly, it is not possible to file a terminal disclaimer to overcome the double patenting rejection.

Nevertheless, the resolution of this issue is relatively straightforward. Material used to replace an intervertebral disk requires certain characteristics (resistance to load bearing that is present in the spinal column, for example) that is not required of more general “tissue augmentation” at other locations, so that materials that are suitable for tissue augmentation at other locations are generally not suitable for disk replacement. For example, a breast implant material would not generally be considered to be a satisfactory disk replacement material. On the other hand, materials of the present invention have the unusual property of being satisfactory for disk replacement while retaining their ability to act as replacement of other tissues (as disclosed in the specification, but *not recited in the claims*).

Accordingly, applicant has amended the current claims to specifically exclude tissue augmentation when the tissue in question is an intervertebral disk. All independent claims now refer to tissue augmentation or restoration in a mammal “wherein said tissue is other than an intervertebral disk.” Applicant requests that the Examiner reconsider this rejection for the reasons stated above, namely that material used for intervertebral disk repair and for repair of other tissues are generally not interchangeable, and that the present invention as *now* claimed would not be obvious *from the issued claims*.

If the present rejection is repeated, it will be a statement by the Examiner that a material disclosed for use as an intervertebral disk replacement material is obvious for

use as a general tissue augmentation material *in other locations than an intervertebral disk*. Applicant does not understand that to be a correct statement. If the Examiner believes his position regarding the earlier pending claims to be correct with regard to the current amended claims, he is requested to provide evidence that a material disclosed for use as an intervertebral disk replacement material is obvious for use in general tissue augmentation at other locations, as the current claims now only read on tissue augmentation at locations other than intervertebral disks.

Conclusion

A Request for an Extension of Time to file this response is included in the concurrently filed papers

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 843-5070.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, or 1.21 that may be required by this paper, to the extent not already covered by the enclosed extension of time, and to credit any overpayment, to Deposit Account No. 03-3117.

Dated: February 23, 2004

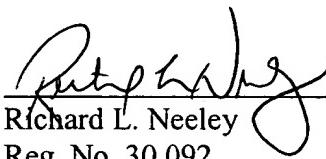
Cooley Godward LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

RLN/ct

652390 v3/PA

Respectfully submitted,
COOLEY GODWARD LLP

By:


Richard L. Neeley
Reg. No. 30,092